REMARKS

Claims 1 to 31, 53, 54, and 66 were pending, and will remain pending upon entry of this amendment.

Claim 69 has been added herein.

Claims 1 to 4, 8, 9, 11, 12, 24, 28 to 30, 53, 54, and 66 have been amended herein.

Claims 1, 53, 54, 66, and 69 will be the only pending independent claims upon entry of this amendment.

All pending claims stand rejected under 35 U.S.C. Section 103(a) as unpatentable over Kaufman (4,624,459) in view of an article entitled "First Double Lotto Jackpot Pays Out Big: Search is on for $16 Million Ticket Holder" dated September 12, 1996 (hereinafter "Double Lotto"). Applicants respectfully traverse this rejection.

The Kaufman reference describes a slot machine that includes a bonus feature wherein a player can win a multiple of the normal payout when the machine is in the bonus mode. The reference does disclose that the multiple may be randomly selected. However, despite the Examiner's assertion to the contrary, there is no teaching regarding the Kaufman invention that a player may request to purchase a multiplier with a random magnitude, or the like, as Applicants have claimed. The background of the Kaufman reference does describe prior art slot machines wherein the number of coins deposited determines a multiplier to be applied to a payout. However, these machines are clearly separate and distinct from the Kaufman system and do not in any way involve a multiplier with a random sized magnitude. These machines have a multiplier solely determined by the number of coins deposited. Thus, even if depositing extra coins in a slot machine was considered to be the same as requesting to purchase a multiplier, which it is not, the Examiner's rejection would still be untenable because no motivation has been provided to combine "a request to purchase a multiplier" with "a multiplier having a random magnitude." Thus, Applicants request withdrawal of the Section 103 rejections for these reasons alone.

Further, even if one would have been motivated to combine the prior art slot machines having a multiplier based on a number of coins deposited with the Kaufman

slot machine having a bonus mode that uses random multipliers, the Examiner's rejection would still not be tenable. This is because a slot machine, as in Kaufman, is fundamentally different than a lottery, as in Applicants' claims. The Examiner has not identified any motivation or suggestion that one of ordinary skill would have taken concepts from a slot machine and applied them to a lottery. The Examiner's unsupported assertion that one would have been so motivated because it would "increase game play and sales in the lottery area" is merely an opinion without any factual basis. Clearly, even if the Examiner's opinion turned out to be correct and the Examiner's presently untried combination was found to increase lottery sales after experimentation, there would still not be anything that suggested making the Examiner's combination in the first place. In other words, a mere desirable result (*i.e.* increasing lottery sales) does not suggest how to achieve the desirable result or even provide a motivation to try combinations that will not clearly achieve the desirable result. The Examiner has not identified any reference or provided any reasoning that suggests slot machine bonus round random multipliers could be applied to a lottery with a fixed multiplier (like Double Lotto), much less do so in a manner that results in increased lottery sales.

Further, Applicants are particularly skeptical of the obviousness of the Examiner's combination because of the fundamental difference between slot machines and lotteries. With a slot machine, the payouts for any outcome are known before a player places a wager. Slot machines typically display the payouts for each outcome on the front of the machine. (See Fig. 1, ref. no. 21 of Kaufman) Slot machine operators are able to use this information to advertise to and entice players. In stark contrast, a lottery is unable to identify upfront what specific outcomes will payout. Lottery ticket purchasers are left to imagine that their purchased entry will be a winner based on the results of a subsequent drawing and determination of numbers or symbols required to receive a payout. Thus, a lottery operator's proposition to entice its customer's is quite different when compared to a slot machine operator's. More specifically, slot machine operators benefit from the ability to disclose to players the necessary symbols required to attain a payout, whereas lottery operators, by nature of the games, are unable to disclose the necessary numbers or symbols that will result in the player obtaining a payout prior to the result of a lottery drawing. Further, lottery operators benefit from this particular

aspect of lottery games in that they may advertise payouts (but not winning numbers or symbols) prior to the results of a drawing being determined, thereby enticing the purchase of more entries. Simply put, it would be impractical for lotteries to announce or advertise the symbols or numbers required to obtain a payout at the time a player places his or her wager (i.e. purchases a ticket), as is done with slot machines. The significance of this distinction (pre-determined outcomes in slot machines vs. later-determined outcomes in lotteries) is that the marketing of slot machines and lotteries are very different, and thus, the two fields are not analogous. Just because a slot machine uses a bonus feature in an attempt to attract players, does not mean that a similar feature would be suggested in a lottery. In fact, because of the marketing differences, most slot machine features are not appropriate for lotteries. Therefore, because one of ordinary skill would not have been motivated to make the Examiner's combination, Applicants respectfully request withdrawal of the Section 103 rejection for this additional reason.

Further, Applicants do not accept nor agree with the Examiner's characterization of the features of the claims that stand rejected based upon Kaufman and Double Lotto in view of factual assertions "Officially Noticed" by the Examiner or otherwise merely asserted as obvious. In each case, the officially-noted subject matter comprises the principal evidence upon which the rejection was based. In other words, the Examiner relies upon officially-noted subject matter to show that a feature of the rejected claim was in the prior art. For the record, Applicants dispute all of the various assertions in the Office Action (with regard to all the claims) regarding what is "well known" and/or otherwise officially-noted. Applicants likewise dispute all assertions which were not proper factual findings because they are mere unsupported conclusions.

Applicants respectfully remind the Examiner that officially-noted subject matter cannot be used as the primary basis for a rejection under 103. In other words, official notice alone of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, *e.g.*, *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference** work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ...

Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added); *In re Eynde*, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and **are not amenable to the taking of judicial or administrative notice**.") (emphasis added); *In re Pardo*, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always **construe [the rule permitting judicial notice] narrowly** and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology **must always be supported by citation to some reference work** recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added) Official Notice may be used, if at all, to clarify the meaning of a reference. See, *e.g.*, *In re Ahlert*, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference** disclosure, perhaps to justify or explain a particular inference to be drawn **from the reference** teaching.") (emphasis added).

Accordingly, Applicants request a reference that describes the officially-noted subject matter in sufficient detail to provide Applicants an opportunity to determine its scope and an opportunity to distinguish the prior art from the present invention. MPEP 2144.03. Likewise, if the Examiner is relying upon her own personal knowledge of what was "old and well known," Applicants respectfully request that the Examiner provide an affidavit in support of her factual assertions. Short of such support for the Examiner's factual assertions, Applicants respectfully request withdrawal of the Section 103 rejection on this additional ground.

Regardless of the above and solely to expedite prosecution of this application, Applicants have amended each of the pending independent claims herein to recite that a price is determined for a multiplier with a randomly selected magnitude, or the like. This feature is clearly not taught, nor even suggested by any combination of the references.

Kaufman's random multiplier is not purchased, as discussed above, and the multiplier in Double Lotto is not random. As the references do not teach or suggest pricing a randomly selected multiplier option for a lottery, Applicants respectfully request that the Examiner withdraw the Section 103 rejection.

Conclusion

Applicants believe that all of the pending claims are in condition for allowance. The Examiner's early re-examination and consideration are respectfully requested. If there remains any question regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Steven Santisi at telephone number (203)461-7054 or via electronic mail at ssantisi@walkerdigital.com.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

December 31, 2003
Date

Steven Santisi
ssantisi@walkerdigital.com
Registration No. 40,157
Attorney for Applicants
Walker Digital, LLC
(203) 461-7054 /voice
(203) 461-7300 /fax